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Mark Freier

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Thomas C. Pontani, Esq.  
Cohen, Pontani, Lieberman & Pavane  
Suite 1210  
551 Fifth Avenue  
New York, NY 10176

EXAMINER

THALER, MICHAEL H

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 10/002,523  
Filing Date: November 02, 2001  
Appellant(s): FREIER ET AL.

MAILED  
JUN 07 2007  
Group 3700

Alfred W. Froebrich  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 29, 2007  
appealing from the Office action mailed July 13, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

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The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,953,559	SALERNO	9-1990
4,569,131	FALK ET AL.	2-1986

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 8 and 10-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Salerno (4,953,559) in view of Falk et al. (4,569,131). Salerno discloses hollow shank 1, scoop 2 which defines a spoon-shaped trough having an opening (at the top of the trough) and a closed end (at the left or bottom of the trough) handling means (at the proximal end of shank 1) having an actuation mechanism 28, actuating rod 15 and covering (the combination of parts 4, 5 and 12 which are secured together) comprising a tongue (member 4, 5, 12 is a "tongue" since it is flat, planar, wide and long along most of its length, i.e., along portions 5 and 12 such that its overall shape including part 4 is similar to the human body part of a tongue), said tongue being slidably adjustable so that said tongue slides along a longitudinal length of said tongue (Tongue 4, 5, 12 slides within hollow shank 1 as it pivots since the

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exterior surface of portion 12 slidably engages the inner sides of notch 7 of shank 1. Further, the tongue slides "along a longitudinal length of said tongue" since it slides along the longitudinal length of portion 12 of the tongue. In other words, the sliding action occurs in portion 12 which extends along the longitudinal length of the tongue. The Merriam-Webster Online Dictionary defines "along" as "at a point or points on <a house *along* the river>". The sliding action of the tongue 4, 15, 12 extends at points on portion 12 of the tongue.) between a closure position and an open position (as it pivots), the position of the tongue being maintained without external force on the actuating rod. Salerno fails to disclose the actuating rod being releasably connectable with actuation mechanism. However, Falk et al. teach that the actuation rod 8 of a surgical instrument should be detachable from the actuation mechanism 3 apparently in order to obtain the advantage of enabling the parts to be detached to better sterilize them or to replace them when a part becomes defective. It would have been obvious to make the connection between the actuating rod and the actuation mechanism of the Salerno instrument releasable so that it too would have these advantages. As to claims 11 and 18, Salerno discloses a holding-down device (the pivot pin 9 upon which the covering 4, 5, 12 pivots) which holds the covering 4,

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5, 12 onto the rest of the instrument and which guides the covering and holds it closed since it holds the covering in position. As to claim 12, the edge is at an angle relative to a longitudinal axis of the hollow shank 2 such that a retrograde inclination is exhibited by the edge of the scoop when the flexible catheter 1 is bent in the body or in the embodiment described in col. 4, lines 26-31. As to claim 13, the covering 4, 5, 12 is inherently bendable to some extent since it is thin. As to claims 15 and 16, the volume defined by the scoop is separated from a volume defined by the hollow shank. As to claim 17, covering 4, 5, 12 comprises a thin strip. It is, in fact, axially displaced as it pivots since it moves to the left as it pivots closed. Further, it is displaced "along the longitudinal length thereof" since the entire longitudinal length of the covering is displaced as it pivots. As to claim 19, Salerno discloses sleeve 27, external ring 28, inner ring (the eyelet referred to in col. 4, line 11) and fastening bar 31.

**(10) Response to Argument**

Appellant, on page 5 of the brief, admits that one of the definitions of "along" is "at a point or points on", but argues that this definition is not an appropriate one given the context of the term "along" in claim 8. Appellant further argues that

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the only appropriate definition of "along" is "in a line matching the length or direction of". These arguments are not persuasive for the following reasons: The claimed terms are given their broadest reasonable meaning consistent with the specification. The specification fails to include any special definition for the term "along". The meaning of the term "along" which is used by the examiner is totally consistent with appellant's specification. That is, tongue 7 of the application slides. Further, the sliding action of tongue 7 exists along the longitudinal length of the tongue 7. The sliding action does not exist at or along the end edges of the tongue. For example, a long cylindrical fluorescent light may be said to emit light all along its length, even though the direction in which the light is emitted is generally perpendicular to the longitudinal length of the fluorescent light tube. Similarly, a ruler that is one inch wide and 12 inches long, when placed flat and horizontally on a desk and slid on top of the desk in any direction may be said to slide along the longitudinal length of ruler. This is because the sliding action exists along the longitudinal length of the ruler. However, this same ruler, when oriented vertically with the one inch end contacting the desk top and sliding on the top of the desk, may not be said to slide along the longitudinal length of the ruler. Instead, the

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ruler slides along its one inch end. Similarly, tongue 7 of the application slides along the longitudinal length of the tongue but not its end. Thus, the meaning of the term "along" which is used by the examiner is totally consistent with appellant's specification. Further, the claims do not require the tongue to slide along the entire length of the tongue, but merely along a longitudinal length of the tongue. The Salerno tongue 4, 5, 12 slides along a longitudinal length (i.e. the longitudinal length of portion 12) of the tongue.

Appellant, on page 6 of the brief, argues that appendage 4 Salerno may not be considered a thin strip. In response, it is submitted that the Salerno tongue is considered to be members 4, 5, 12. This tongue is thin and is a strip at flat portion 6 of lever 5 which is thin and which is a strip and at portion 4 which is thin and which is a curved strip.

Appellant, on pages 6 and 7 of the brief, argues that the Salerno tongue does not moves across the opening in the trough. In response, it is submitted that the Salerno tongue moves "across the opening" as claimed since in one position (the closed position) it extends completely across the opening while in another position (the open position) it is not completely across the opening because the left edge of the tongue is spaced slightly to the right of the left edge of the opening due to the



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axial component of the pivotal movement of the tongue and since the tongue is spaced above the opening.

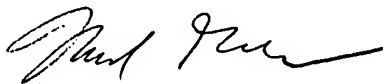
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

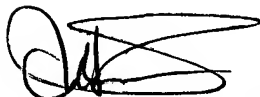
Respectfully submitted,

MICHAEL H. THALER  
PRIMARY EXAMINER  
ART UNIT 3731



Conferees:

  
ANH TUAN T. NGUYEN



HEATHER C. SHACKELFORD